



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,739	07/25/2001	Toyohiko Yoshida	57454-180	5586

7590 10/14/2008  
McDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
----------

PETRANEK, JACOB ANDREW

ART UNIT	PAPER NUMBER
----------	--------------

2183

MAIL DATE	DELIVERY MODE
-----------	---------------

10/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte TOYOHICO YOSHIDA

---

Application No. 09/911,739  
Technology Center 2100

---

Mailed: October 14, 2008

---

Before DALE M. SHAW *Chief Appeals Administrator.*

SHAW, *Chief Appeals Administrator.*

ORDER RETURNING UNDOCKETED APPEAL

This application was received electronically at the Board of Patent Appeals and Interferences on April 9, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

Application No. 09/852,562

An Examiner's Answer was mailed on November 17, 2006. The Evidence Relied Upon section, page 3, states that "No evidence is relied upon by the examiner in the rejection of the claims under appeal." A review of the file reveals that prior art was applied to the Rejections on appeal. See the Grounds of Rejection on page 4 of the Examiner's Answer. The Manual of Patent Examining Procedure, (MPEP), in §1207.02 states:

(8) *Evidence Relied Upon*. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Also, the Examiner's Answer mailed November 17, 2006 is defective because a new ground of rejection, where Claims 6, 12 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Augusteijn et al. (U.S. 6,292,883), Further in view of Jouppi (U.S. 5,386,547).

When a new ground of rejection is introduced in the Examiner's Answer, the Examiner is required to obtain approval of the Technology Center Director or his/her designee. See MPEP § 1207.02.

Accordingly, it is

**ORDERED** that the application is returned to the Examiner:

1) vacate the Examiner's Answer mailed November 17, 2006, and mail a

Application No. 09/911,739

Supplemental Examiner's Answer including the missing reference(s) listed under the Evidence Relied Upon, heading (8);

2) obtain approval of the Technology Center Director or designee for the new ground of rejection, and

3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DMS/gjh

McDERMOTT, WILL & EMERY  
600 13<sup>TH</sup> STREET N. W.  
WASHINGTON, DC 20005-3096